

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 27, 2008. At the time of the Office Action, Claims 1-17 were pending in this Application. Claims 1-17 were rejected. Claims 5, 6, 11, 12, 16, and 17 have been amended to correct informalities. Claim 18 has been added. Applicants respectfully request reconsideration and favorable action in this case.

Claim Objections

Claims 5-6, 11-13 and 16-17 were objected due to insufficient antecedent basis for the limitation in the claims. Applicants have amended Claims 5, 6, 11, 12, 16, and 17 accordingly.

Rejections under 35 U.S.C. §103

Claims 1-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of U.S. Patent No. 4,536,816 issued to Susumu Matsumura et al. ("*Matsumura*") Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination

was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Examiner stated correctly that the acknowledged prior art (“AAPA”) does not disclose the reception unit of the trigger circuit having at least one power semiconductor component. The Examiner, however, concluded that because *Matsumura* discloses a switchable power semiconductor component, a person skilled in the art would modify the circuit disclosed in AAPA to replace the trigger spark gap of the AAPA with a semiconductor as taught by *Matsumura*. Applicant respectfully disagrees.

The Examiner’s are combinations are not sufficient to support a finding of obviousness because “[t]he key to supporting any rejection under 35 U.S.C. [§] 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” M.P.E.P. § 2143 (emphasis added). The M.P.E.P. also states that “the analysis supporting a rejection under 35 U.S.C. [§] 103 should be *made explicit.* *Id.* (emphasis added). M.P.E.P. § 2143 also sets forth a host of exemplary rationales and Examiner may employ in maintaining a rejection, including particular findings of fact required to support each such rationale. In the present case, the Examiner has not made any such rationale explicit, has not supported the rejection using any rationale set forth in M.P.E.P. § 2143 or other suitable rationale, and has not made any factual findings to support any such rationale. For example, if the Examiner maintains rejections on a rationale the some teaching, suggestion or motivation in the prior art would have led one of ordinary skill in the art to modify and/or combine prior art references, the Examiner must make and articulate each of the following findings:

- a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings;
- a finding that there was reasonable expectation of success; and
- whatever additional findings based on the factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1 (1966) as may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Matsumura does not teach to provide a power semiconductor component for use in a high voltage surge protector. Therefore, a person skilled in the art would not learn from *Matsumura* that such a device could be used beneficially in a surge protector using spark gaps. There is neither a teaching nor a suggestion in the cited prior art that a thyristor beneficially can substitute a spark gap. Neither AAPA nor *Matsumura* teach such a substitution. On the contrary, *Matsumura* teaches the use of a light triggerable thyristor 13 in a power switch for providing a phase controlled modulator in which the thyristor is coupled between the main power supply and a load. See, *Matsumura* Figs. 6 and 7 and associated description. Thus, even if a person skilled in the art would consider *Matsumura*, which Applicant does not concede, there is no hint in *Matsumura* to replace a spark gap with a thyristor. The only teaching with respect to replacement of a switch is that a conventional electrically controlled thyristor 1 can be replaced by a light triggered thyristor. However, the circuit according AAPA does not have such a device. *Matsumura* does not mention any type of spark gap or any type of application of the circuit in a surge protector, let alone in a surge protector using a spark gap.

With respect to claims 2, 8, and 17, these claims include that the power semiconductor components are in the form of thyristors which are connected in opposition and can be triggered optically. In other words these claims define that the thyristors are coupled inversely as shown in Figs. 2 and 3 of the present application. The Examiner stated that *Matsumura* teaches this limitation in col. 4, lines 33-42. Applicant respectfully disagrees. *Matsumura* neither teaches nor suggests to use inversely coupled thyristors. Hence these claims are not rendered obvious by the cited prior art.

Hence, Applicant believes that the present independent claims are not rendered obvious by the prior art. Applicants respectfully submit that the remaining dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants authorize the Commissioner to charge the amount of \$210.00 for new independent Claim 8 to Deposit Account No. 50-2148.

Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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